

ESTTA Tracking number: **ESTTA499433**

Filing date: **10/10/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

Opposers Information

Name	Jacqueline Nelson C/O Katten Muchin Rosenman LLP
Granted to Date of previous extension	10/24/2012
Address	William Dorsey 525 W. Monroe Street Chicago, IL 60661 UNITED STATES
Party who filed Extension of time to oppose	JacquelineNelson
Relationship to party who filed Extension of time to oppose	To have a correct mailing address.

Name	The George Nelson Foundation d/b/a The George Nelson Design Foundation
Granted to Date of previous extension	10/24/2012
Address	174 Oakwood Avenue Holland, MI 49424 UNITED STATES

Attorney information	William Dorsey, Christine Bestor Katten Muchin Rosenman LLP 525 W. Monroe Street Chicago, IL 60661 UNITED STATES william.dorsey@kattenlaw.com, christine.bestor@kattenlaw.com, carolyn.passen@kattenlaw.com, deborah.wing@kattenlaw.com, shirley.cole@kattenlaw.com Phone:3129025200
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Applicant Information

Application No	85186745	Publication date	06/26/2012
Opposition Filing Date	10/10/2012	Opposition Period Ends	10/24/2012
Applicant	Modernica, Inc. 2118 E 7th Pl Los Angeles, CA 90021 UNITED STATES		

Goods/Services Affected by Opposition

Class 008.

All goods and services in the class are opposed, namely: Fireplace tongs; fire irons; fireplace pokers; fireplace shovels; fireplace tool sets consisting of a shovel, grate, poker, fire screen and fire lighter, all sold together as a unit

Applicant Information

Application No	85186747	Publication date	08/14/2012
Opposition Filing Date	10/10/2012	Opposition Period Ends	
Applicant	Modernica, Inc. 2118 E 7th Pl Los Angeles, CA 90021 UNITED STATES		

Goods/Services Affected by Opposition

Class 008.

All goods and services in the class are opposed, namely: Fireplace tongs; fire irons; fireplace pokers; fireplace shovels; fireplace tool sets consisting of a shovel, grate, poker, fire screen and fire lighter, all sold together as a unit

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is primarily merely a surname	Trademark Act section 2(e)(4)

Marks Cited by Opposer as Basis for Opposition

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	GEORGE NELSON		
Goods/Services	Furnishings, including fireplace tools, benches, cabinets, sofas, chairs, bedroom pieces, wall clocks, table clocks, tables, lamps, planters, room dividers, etc.		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	NELSON		
Goods/Services	Furnishings, including fireplace tools, benches, cabinets, sofas, chairs, bedroom pieces, wall clocks, table clocks, tables, lamps, planters, room dividers, etc.		

Attachments	101012 FINAL NOTICE OF OPPOSITION.pdf (8 pages)(23520 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/s/Christine E. Bestor
Name	Christine Bestor
Date	10/10/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of U.S. Trademark Application No. 85186745
For the mark GEORGE NELSON
Filing date: November 29, 2010
Date published: June 26, 2012

In the matter of U.S. Trademark Application No. 85186747
For the mark NELSON
Filing date: November 29, 2010
Date published: August 14, 2012

Jacqueline Nelson and
The George Nelson Foundation,

Opposers,

V.

Modernica, Inc.,

Applicant.

Opposition No. _____

CONSOLIDATED NOTICE OF OPPOSITION

Opposers Jacqueline Nelson and The George Nelson Foundation (collectively, “Opposers”) maintain that they will be damaged by, and hereby oppose the registration of, the following U.S. Trademark Applications (collectively, the “Applications”):

- GEORGE NELSON, U.S. Trademark Application Serial No. 85186745, for “[f]ireplace tongs; fire irons; fireplace poker; fireplace shovel; fireplace tool sets consisting of a shovel, grate, poker, fire screen and fire lighter, all sold together as a unit” in International Class 8; and,
- NELSON, U.S. Trademark Application No. 85186747, for “[f]ireplace tongs; fire irons; fireplace poker; fireplace shovel; fireplace tool sets consisting of a shovel, grate, poker, fire screen and fire lighter, all sold together as a unit” in International Class 8.

To the best of Opposers' knowledge, based on the TARR database of the United States Patent and Trademark Office ("Trademark Office"), the name and address of the current owner

of the Applications is Modernica, Inc. (“Applicant”), a California corporation located at 2118 E. 7th Pl., Los Angeles, California 90021, and the attorney for the Applications is Victor K. Sapphire at Connolly Bove Lodge & Hutz LLP, 333 S. Grand Ave Ste 2300, Los Angeles, California 90071-1529.

As grounds for their opposition, Opposers allege as follows:

1. Ms. Jacqueline Nelson (“Ms. Nelson”), an individual residing in New York City, New York, is the widow and sole heir to the intellectual property rights of the late George Nelson, including the GEORGE NELSON and NELSON name and marks.

2. The George Nelson Foundation, a nonprofit Michigan corporation with an address at 174 Oakwood Avenue, Holland, Michigan 49424, is a nonprofit foundation endorsed and entrusted by Ms. Nelson with powers to protect and defend the intellectual property rights of George Nelson, including the GEORGE NELSON and NELSON name and marks.

BACKGROUND FACTS

3. George Nelson is a famous American industrial designer and one of the founding fathers of American Modernism. During his lifetime, George Nelson and his firm, George Nelson & Associates, designed much of the 20th century’s most iconic modern furniture, including benches, cabinets, sofas (e.g., the “Marshmallow sofa”), chairs, settees, bedroom pieces, wall and table clocks, tables, lamps (e.g., the “Bubble lamps”), wrought iron fireplace pieces and tools, planters, room dividers, the Action Office (a precursor to the modern office cubicle), and many other products that became milestones in the history of a profession that George Nelson helped shape.

4. Born in Hartford, Connecticut in 1908, George Nelson joined *Architectural Forum* in 1935, where he served first as associate direct and later as consulting editor. In 1942, George Nelson developed the then-groundbreaking concept of the downtown pedestrian mall,

which was unveiled in the *Saturday Evening Post*. Soon after, George Nelson designed the “Storagewall,” the first modular storage system and a forerunner of systems furniture. The Storagewall was showcased in a 1945 *Life* magazine article, causing a sensation in the furniture industry. It was at or around that time when George Nelson was appointed to the coveted position of director of design for the famed Herman Miller, Inc., and founded his own family design firm George Nelson & Associates.

5. George Nelson and his firm created a stunning range of products and many landmark designs, showrooms, and exhibitions for a variety of companies and organizations. George Nelson received numerous awards and recognition for his design legacy, including places in the permanent collections of the Museum of Modern Art, Brooklyn Museum of Art, and Philadelphia Museum of Art; Lifetime Achievement Award, American Institute of Graphic Arts (1991); Scholar in Residence, Smithsonian Institute National Museum of Design (1984); Chairman, International Design Conference in Aspen (1965 and 1982); Good Design Award, Museum of Modern Art (1954); Trailblazer Award, National Home Furnishings League (1954); Best Office of the Year, New York Times (1953); Gold Medal, Art Directors Club of New York (1953); and Prix de Rome for architecture (1932). George Nelson also authored and co-authored several iconic books on Modern American design, including *Tomorrow’s House* (1945), *Living Spaces* (1952), *Chairs and Display* (1953), *Storage* (1954), *Problems with Design* (1957), *How to See: Visual Adventures in a World God Never Made* (1977), and *George Nelson on Design* (1979). He has also been the subject of many books, including *George Nelson: Architect / Writer / Designer / Teacher* (2009) and *George Nelson: The Design of Modern Design* (2000).

6. George Nelson developed and enjoyed extensive goodwill and recognition throughout the United States and the world with respect to his name and marks, GEORGE

NELSON and NELSON, for design, furniture and household accessories. There are many current and past references to the name and mark GEORGE NELSON and its association with George Nelson. Many original products designed and created by George Nelson have been in circulation in commerce since first designed decades earlier, and are still found at high-end modern art and furniture sales, auctions, and museum stores, including the Museum of Modern Art in New York. George Nelson's iconic furniture and home accessories are also still manufactured, marketed and sold by authorized licensees in the United States and Europe.

7. George Nelson passed away in New York City on March 5, 1986, at which time his widow and sole heir to his intellectual property rights, Ms. Jacqueline Nelson, inherited all of George Nelson's intellectual property rights, including the GEORGE NELSON and NELSON name and marks. Since then, Ms. Nelson has continued to license the GEORGE NELSON name and mark to authorized licensees for use with licensed GEORGE NELSON products and designs. Ms. Nelson has also endorsed and empowered The George Nelson Foundation to protect and defend the intellectual property rights of George Nelson, including the GEORGE NELSON and NELSON name and marks.

8. Applicant filed its Intent-to-Use Applications for GEORGE NELSON and NELSON on November 29, 2010 for "fireplace tongs; fire irons; fireplace pokers; fireplace shovels; fireplace tool sets consisting of a shovel, grate, poker, fire screen and fire lighter, all sold together as a unit" in International Class 8.

FALSE SUGGESTION OF CONNECTION

9. Opposers reallege and incorporate herein by reference the matters alleged in Paragraphs 1 through 8 of this Consolidated Notice of Opposition.

10. Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), prohibits registration of a mark which disparages or falsely suggests a connection with persons living or dead, institutions, beliefs, or national symbols, or which bring them into contempt or disrepute.

11. Applicant's proposed marks GEORGE NELSON and NELSON falsely suggest a connection with the late George Nelson and have a potential to disparage, bring into contempt or disrepute the name "George Nelson" or otherwise invade upon rights of privacy and publicity which Opposers seek to defend.

12. At the time Applicant signed its declaration, the GEORGE NELSON and NELSON marks and name had been used by George Nelson and his successors for a period of decades for goods and services similar to Applicant's proposed goods.

13. Applicant had knowledge of the public recognition of the term GEORGE NELSON and NELSON as referring to the late George Nelson when Applicant filed the Applications.

14. Indeed, in its September 6, 2011 Responses to Office Actions for both of the Applications (Serial Nos. 85186745 and 85186747), Applicant acknowledged the public recognition of the terms GEORGE NELSON and NELSON as referring to the late George Nelson when Applicant stated that "the famed mid-century modern designer George Nelson (1908-1986) is credited with the design of a series of culturally iconic wall clocks that are commonly identified as 'George Nelson' clocks."

15. Applicant's proposed marks GEORGE NELSON and NELSON, for fireplace tools and sets, would be recognized as identifying or falsely suggesting a connection with George Nelson in that it points uniquely and unmistakably to him. During his lifetime, George

Nelson designed and created numerous household accessories, including fireplace tools and sets, which became iconic and famous.

16. Neither George Nelson nor Opposers are connected with Applicant or the products that Applicant intends to market and/or produce under the proposed mark GEORGE NELSON and NELSON.

17. The fame or reputation of George Nelson is such that, if the proposed mark GEORGE NELSON and NELSON are used with Applicant's proposed goods—the type of goods that George Nelson himself designed, created and sold—a connection with George Nelson would be presumed.

LIKELIHOOD OF CONFUSION AND DILUTION

18. Opposers reallege and incorporate herein by reference the matters alleged in Paragraphs 1 through 17 of this Consolidated Notice of Opposition.

19. Opposers' predecessor, George Nelson, began using his name and marks GEORGE NELSON and NELSON for furniture and household accessories in or about 1945. Since George Nelson's death in 1986, his widow and heir, Ms. Nelson, has continued to license the GEORGE NELSON and NELSON marks to authorized licensees to manufacture, create, market, and sell George Nelson's designs and household goods, including furniture, home accessories, lamps/lighting and clocks. The GEORGE NELSON name and mark is well-known and famous in the United States.

20. Applicant's proposed goods offered under the GEORGE NELSON and NELSON marks would be so closely related to the goods and services offered by Opposers and their authorized licensees, as to be likely to cause confusion, mistake, or deception in the minds of the purchasing public as to the source of origin of Applicant's goods, in view of Opposers' prior use

of the GEORGE NELSON and NELSON name and marks and well developed secondary meaning therein, in violation of § 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), with consequent damage to Opposers and the public.

21. Applicant's proposed GEORGE NELSON and NELSON marks in the Applications will cause dilution of the distinctive quality of Opposers' GEORGE NELSON and NELSON marks, in violation of 15 U.S.C. § 1063(a) and § 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), with consequent damage to Opposers and the public.

PRIMARILY MERELY A SURNAME

22. Opposers reallege and incorporate herein by reference the matters alleged in Paragraphs 1 through 21 of this Consolidated Notice of Opposition.

23. Section 2(e)(4) of the Lanham Act, 15 U.S.C. §1052(e)(4), precludes registration of a mark which is "primarily merely a surname" without a showing of acquired distinctiveness.

24. Applicant's Intent-to-Use trademark application for the mark NELSON (Serial No. 85186747) is primarily merely a surname without any acquired distinctiveness symbolizing Applicant. As discussed above, NELSON is the surname of the late George Nelson.

25. The surname "Nelson" is not rare. Nelson is ranked the 39th most common surname in the United States.

26. Upon information and belief, no one connected with Applicant has "Nelson" as a surname. As discussed above, Applicant's intent in registering the mark NELSON is to falsely suggest a connection with the late George Nelson and the products and household accessories that he designed during his lifetime.

27. The mark NELSON has no other recognized meaning other than as a surname, and the mark NELSON has the "look and feel" of a surname.

28. Consumers do not identify the mark NELSON with Applicant or Applicant's proposed goods set forth in its Intent-to-Use trademark application, and the mark NELSON has not acquired any distinctiveness symbolizing Applicant or its proposed goods.

WHEREFORE, Opposers respectfully request that the marks shown in U.S. Trademark Application Serial Nos. 85186745 and 85186747 be refused registration and that this Opposition be sustained.

Dated: October 10, 2012

Respectfully submitted,

By: /s/ William J. Dorsey

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